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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/453.327	12/02/99	HEENAN	S 096990-026-1 <i>du</i>

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EXAMINER

PHAN, J

ART UNIT

PAPER NUMBER

2872

DATE MAILED:

11/06/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/453,327

Applicant(s)
Heenan et al

Examiner
James Phan

Group Art Unit
2872



☒ Responsive to communication(s) filed on Sep 1, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-94 is/are pending in the application.

Of the above, claim(s) 14-25, 27, 28, and 31-93 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-11, 26, 29, 30, and 94 is/are rejected.

☒ Claim(s) 12 and 13 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 8 and 9

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2872

DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of Group I, species (5) in Paper No. 11 is acknowledged. The traversal is on the ground(s) that Group II invention (claims 18 and 91-93) should also be examined together with claims 1-13, 26, 29-30 and 94 since it has the structure disclosed in the elected species (5). This is not found persuasive because claims 18 and 91-93 drawn to a pavement marker which is patentably distinct from the elected Group I invention for the reason discussed in paper no. 10.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 14-25, 27-28, 31-93 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention.

3. The elected species (5) discloses unpaired rectangular cubes; therefore, the alternative "or pentagonal" recited in claim 13, line 4, and in claim 94, line 3, is also withdrawn from further consideration. The alternative "or pentagonal" recited in claim 13, line 4, and in claim 94, line 3, should be deleted.

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Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-4, 11, 13 and 94 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3-4 of U.S. Patent No. 6015214. Although the conflicting claims are not identical, they are not patentably distinct from each other because every limitation recited in application claims is disclosed in the patent claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-11 and 29-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Jungersen.

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Jungersen discloses a retroreflective sheeting comprising square microcubes 41 which are not hexagonal. See Fig. 11.

In re claim 8 the material selected for the retroreflective sheeting is conventional and thus, it is inherently disclosed in Jungersen.

In re claims 9 and 10 the method of forming the microcubes does not make the microcubes patentably distinct from the microcubes disclosed in Jungersen.

In re claims 29-30 the recited feature is each of the claims is conventional and thus, it is inherently disclosed in Jungersen.

7. Claims 1-3, 7-11, 26, 29-30 and 94 are rejected under 35 U.S.C. 102(b) as being anticipated by Heasley '568 (see Figs. 1-8) or Lindner '773 . Note that the term "microcubes" recited in the claims has been interpreted as "little" or "small" or "minute" (see Webster's New World Dictionary, Third College Edition) cubes.

8. Claims 1-11, 26, 29-30 and 94 are rejected under 35 U.S.C. 102(b) as being anticipated by Heenan '090. See Figs. 8 and 10-12 and the accompanying text.

In re claims 29-30 the recited feature is each of the claims is conventional and thus, it is inherently disclosed in the Heenan patent.

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Allowable Subject Matter

9. Claims 12-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter: none of the cited references teaches or fairly suggests an article having the structure specified in claims 12-13.

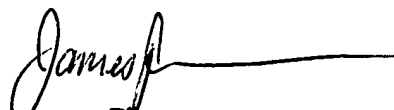
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Phan whose telephone number is (703) 308-4810. The fax phone number for this Group is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Phan, J.

October 26, 2000


James Phan
Primary Examiner